

REMARKS

Claims 1-25 are pending and under consideration. Claims 1, 2, and 18-23 are amended herein. Support for the amendments to the claims may be found in the claims as filed originally. Claims 24 and 25 are added herein. Support for new claims 24 and 25 may be found in claims 1 and 23, respectively. Reconsideration is requested based on the foregoing amendment and the following remarks.

Claim Rejections - 35 U.S.C. § 103:

Claims 1-23 were rejected under 35 U.S.C. § 103 as being unpatentable over Reilly et al. US 5,740,549 (hereinafter "Reilly") in view of NAA® Presstime: NEXPO '97 Report (hereinafter "NEXPO"). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 1 recites, in pertinent part:

"an advertisement preparation unit for preparing an advertisement requested by an advertiser."

Reilly doesn't show an advertisement preparation unit for preparing an advertisement requested by an advertiser, as acknowledged graciously in the Office Action. The Office Action seeks to compensate for this deficiency by combining Reilly with NEXPO. NEXPO, however, shows no advertisement preparation unit for preparing an advertisement requested by an advertiser either, and thus cannot make up for the deficiencies of Reilly with respect to claim 1.

To serve as an anticipating reference the reference must enable that which it is asserted to anticipate.

"A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CA FC 2003):

In particular, for NEXPO to anticipate an advertisement preparation unit for preparing an advertisement requested by an advertiser, NEXPO would have to show a person of skill in the art how to make and use an advertisement preparation unit for preparing an advertisement

requested by an advertiser. NEXPO does not do this. NEXPO, in fact, doesn't even mention an advertisement preparation unit for preparing an advertisement requested by an advertiser, let alone inform the reader how one might be made and used.

NEXPO, rather, is basically an advertising fluff piece itself, there are very few technical details in it at all. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result, since a person of skill in the art would not be able to discern from NEXPO how to make and use an advertisement preparation unit for preparing an advertisement requested by an advertiser.

Furthermore, NEXPO doesn't describe "putting an electronic medium advertisement from advertisers, converting it to an electronic data and placing it on a web page," contrary to the assertion at page 2 of the Office Action. NEXPO, rather, is about luring classified advertisements *back* to print media *from* the Internet, where they have strayed, as described in the second paragraph at page 1 of 8. NEXPO doesn't like web pages, they're competition for newspapers.

Furthermore, the Office Action provides no motivation or suggestion to modify Reilly as required by 35 U.S.C. § 103(a) and the M.P.E.P. § 706.02(j)(D), beyond the assertion that,

"It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reilly's on-line news with NEXPO'97's advertisement publishing or preparation method/system, since the feature provides advertisers control of the preparation and administration of their advertisement."

NEXPO, however, is all about helping newspapers i.e. print media, "wrest back advertisers who have strayed to niche products and the *Internet*," (emphasis added) as described in the second paragraph on page 1 of 8. NEXPO is thus the complete antithesis of Reilly, which is about computer based information *distribution* systems, as described at column 1, lines 4 and 5. The Internet, which NEXPO abhors, is an example of a computer based information distribution system.

It is submitted, therefore, that persons of ordinary skill in the art who read Reilly for all it contained at the time the invention was made would have seen no reason to negate the purpose of Reilly by combining it with NEXPO, contrary to the assertion in the Office Action, since to do so would only foment the flight of advertisers to the Internet that NEXPO is seeking to deter.

Furthermore, NEXPO is about advertisers helping to formulate their own newspaper i.e. print media, classified ads, as described in the first and the third paragraphs at page 4 of 8. The

audience for NEXPO, therefore, is really comprised of opponents of Reilly, which is about,

“a system for distributing to a set of subscribers' computers information matching each subscriber's interests as well as advertising, and for distributing the information and advertising to each subscriber's computer during time periods in which the subscriber's computer is otherwise inactive,”

as described at column 1, lines 5-10. It is submitted, therefore, that persons of ordinary skill in the art who read Reilly for all it contained at the time the invention was made would have seen no reason to negate the purpose of Reilly by combining it with NEXPO, contrary to the assertion in the Office Action, since none of the folks who read NEXPO would want to be a party to the computer based information distribution system of Reilly.

Reilly, in fact, teaches away from the modification proposed by the Office Action at column 1, line 21, where he describes advertisements with opprobrium, “when the main program to which they are listening or viewing is interrupted by advertisements.” It is submitted that interrupting a main program to which viewers are listening or viewing by advertisements is exactly why an advertisement preparation unit would be used for preparing an advertisement requested by an advertiser.

Furthermore, as described in Reilly at column 2, lines 17-24,

The use of large bandwidth data transmissions is not economically practical in the context of data dissemination via the Internet and other computer networks, although the cost of such data transmissions will undoubtedly continue to decrease. As a result, graphics and animation have typically received relatively little use in computer network based information dissemination systems.

Since, according to Reilly, the use of large bandwidth data transmissions is not economically practical, it is submitted that persons of ordinary skill in the art at the time the invention was made would have been deterred from providing an advertisement preparation unit for preparing an advertisement requested by an advertiser, contrary to the assertion in the Office Action.

Furthermore, as described in Reilly at column 2, lines 47-53,

Another goal of the present invention is provide each subscriber with the ability to set up and change a user profile indicating categories and subcategories of topics which are of interest and not of interest to the subscriber, and to select the news stories displayed on the subscriber's computer accordingly.

Since, according to Reilly, a goal of the present invention is to provide each subscriber with the ability to set up and change a user profile indicating categories and subcategories of topics which are of interest and not of interest to the *subscriber*, it is submitted that persons of

ordinary skill in the art at the time the invention was made would have been deterred from providing an advertisement preparation unit for preparing an advertisement requested by an advertiser, contrary to the assertion in the Office Action. The odds of an advertisement requested by an *advertiser* being simultaneously of interest to the *subscriber* are vanishingly small.

Finally, as described in Reilly at column 3, lines 20-24,

The information display controller includes a filter for excluding from the information items displayed on the display device those information items inconsistent with the subscriber profile data.

Since, according to Reilly, the information display controller includes a filter for excluding from the information items displayed on the display device those information items inconsistent with the subscriber profile data, it is submitted that persons of ordinary skill in the art at the time the invention was made would have been deterred from providing an advertisement preparation unit for preparing an advertisement requested by an advertiser, contrary to the assertion in the Office Action. The odds of an advertisement requested by an *advertiser* being simultaneously inconsistent with the subscriber profile data are great.

Claim 1 recites further,

"wherein the second service is provided to the user at an independent time and by a different medium from the first service."

Neither Reilly nor NEXPO teach, disclose, or suggest a second service that is provided to the user at an independent time and by a different medium from a first service, as recited in claim 1. In particular, in claim 1, a second service, *i.e.* perusal of an advertisement, is provided to a user at a timing independent of a first service, *i.e.* subscription to a newspaper, and on a different medium. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3-17 depend from claim 1 and add additional distinguishing elements. Claims 3-17 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3-17 is earnestly solicited.

Claim 2:

Claim 2 recites, in pertinent part:

"an advertisement preparation unit for preparing an advertisement requested by an

advertiser and for placing said advertisement on a Web page so as to be viewed.”

Reilly doesn’t show an advertisement preparation unit for preparing an advertisement requested by an advertiser, as acknowledged graciously in the Office Action. The Office Action seeks to compensate for this deficiency by combining Reilly with NEXPO. NEXPO, however, shows no advertisement preparation unit for preparing an advertisement requested by an advertiser either, as discussed above with respect to the rejection of claim 1, and thus cannot make up for the deficiencies of Reilly with respect to claim 2. Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as also discussed above with respect to the rejection of claim 1.

Claim 2 recites further,

“wherein the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.”

Neither Reilly nor NEXPO teach, disclose, or suggest a second service that is provided to the user at an independent time and by a different medium from a first service, as recited in claim 2. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result. Claim 2 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 2 is earnestly solicited.

Claim 18:

Claim 18 recites, in pertinent part:

“wherein the second service is provided to the user at an independent time and by a different medium from the first service.”

Neither Reilly nor NEXPO teach, disclose, or suggest a second service that is provided to the user at an independent time and by a different medium from a first service, as recited in claim 18. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as discussed above with respect to the rejection of claim 1. Claim 18 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of

claim 18 is earnestly solicited.

Claim 19:

Claim 19 recites, in pertinent part:

“wherein the second service is provided to the user at an independent time and by a different medium from the first service.”

Neither Reilly nor NEXPO teach, disclose, or suggest a second service that is provided to the user at an independent time and by a different medium from a first service, as recited in claim 19. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as discussed above with respect to the rejection of claim 1. Claim 19 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 19 is earnestly solicited.

Claim 20:

Claim 20 recites, in pertinent part:

“wherein the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.”

Neither Reilly nor NEXPO teach, disclose, or suggest an advertisement view that is provided to the user at an independent time and by a different medium from a delivery of a newspaper, as recited in claim 20. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as discussed above with respect to the rejection of claim 1. Claim 20 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 20 is earnestly solicited.

Claim 21:

Claim 21 recites, in pertinent part:

“wherein the second service is provided to the user at an independent time and by a different medium from the first service.”

Neither Reilly nor NEXPO teach, disclose, or suggest a second service that is provided to the user at an independent time and by a different medium from the first service, as recited in claim 21. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as discussed above with respect to the rejection of claim 1. Claim 21 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 21 is earnestly solicited.

Claim 22:

Claim 22 recites, in pertinent part:

“wherein the advertisement view is provided to the user at an independent time and by a different medium from a delivery of a newspaper.”

Neither Reilly nor NEXPO teach, disclose, or suggest an advertisement view that is provided to the user at an independent time and by a different medium from a delivery of a newspaper, as recited in claim 22. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as discussed above with respect to the rejection of claim 1. Claim 22 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 22 is earnestly solicited.

Claim 23:

Claim 23 recites:

“displaying the advertisement only to the registered users as a privilege.”

Neither Reilly nor NEXPO teach, disclose, or suggest displaying the advertisement only to the registered users as a privilege, as recited in claim 23.

Claim 23 recites further,

“wherein the advertisement display is provided to the user at an independent time and by a different medium from a delivery of a newspaper.”

Neither Reilly nor NEXPO teach, disclose, or suggest an advertisement display that is provided to the user at an independent time and by a different medium from a delivery of a newspaper, as recited in claim 23. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as discussed above with respect to the rejection of claim 1. Claim 23 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 23 is earnestly solicited.

New Claim 24:

Claim 24 recites:

“an advertisement preparation unit for preparing an advertisement requested by an advertiser.”

Neither Reilly nor NEXPO teach, disclose, or suggest displaying the advertisement only to the registered users as a privilege, as discussed above with respect to the rejection of claim 1. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as also discussed above with respect to the rejection of claim 1. Claim 24 is thus believed to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1.

New Claim 25:

Claim 25 recites:

“displaying the advertisement only to the registered users as a privilege.”

Neither Reilly nor NEXPO teach, disclose, or suggest displaying the advertisement only to the registered users as a privilege, as discussed above with respect to the rejection of claim 23. Thus, even if Reilly and NEXPO were combined as proposed in the Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art at the time the invention was made would have been deterred from modifying Reilly as proposed in the Office Action, as discussed above with respect to the rejection of claim 1. Claim 25 is thus believed to be allowable, for at least those reasons discussed above with respect to the rejection of claims 1 and 23.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-25 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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